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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/704,256	11/01/2000	Paul Danton Huish	04193.009/1344.1P	3351

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EXAMINER	
DELCOTTO, GREGORY R	
ART UNIT	**PAPER NUMBER**
1751	10

DATE MAILED: 05/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/704,256	HUISH ET AL.	
	Examiner	Art Unit	
	Gregory R. Del Cotto	1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 January 2002* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☒ Claim(s) *21* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *8* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. Claims 1-21 are pending. Applicant's amendments and arguments filed 2/9/02 have been entered.

Applicant's election without traverse of Group I in Paper No. 9 is acknowledged. This requirement is made FINAL.

Objections/Rejections Withdrawn

2. The following objections/rejections as set forth in Paper #6 have been withdrawn:

The rejection of claim 17 under 35 USC 112, second paragraph, has been withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-5 and 16-20 are rejected under 35 U.S.C. 102(b) as being anticipated by, or in the alternative, under 35 USC 103 as obvious over Rolfes (US 5,972,861) for the reasons of record set forth in Paper #6.

Claims 1, 4, 5-10, and 13-19 are rejected under 35 USC 103 as being unpatentable over EP 336,740 for the reasons of record set forth in Paper #6.

Claims 1-20 are rejected under 35 USC 103 as being unpatentable over Kaminsky (US 4,487,710) for the reasons of record set forth in Paper #6.

Claims 8-15 are rejected under 35 USC 103 as being unpatentable over Rolfes (US 5,972,861) for the reasons of record set forth in Paper #6.

Claim 6 is rejected under 35 USC 103 as being unpatentable over Rolfes (US 5,972,861) as applied to claims 1-5 and 16-20 above, and further in view of Kaminsky (US 4,487,710) or EP 336,740.

Claims 1-6, 8, and 16-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Ospinal et al (US 5,965,508).

Ospinal et al teach compositions suitable for formation into mild personal cleansing or laundry detergent bars comprising from about 30% to about 99% by weight of a mixture of anionic surfactants comprising an alpha sulfonated alkyl ester and a sulfonated fatty acid; from about 0.5% to about 50% by weight of a fatty acid, and from about 0.1% to about 50% by weight water. See Abstract. The compositions may also contain from 0.1% to about 10% by weight of an alkali metal inorganic salt such as sodium sulfate, sodium chloride, sodium carbonate, etc. See column 7, lines 25-45. The compositions may also contain detergent surfactants such as anionic, nonionic, amphoteric, etc. See column 9, line 55 to column 12, line 50. Other additional components include detergent builders, enzymes, clays, etc. See column 14, lines 15-30.

Specifically, Ospinal et al teach a toilet bar containing 75% of surfactant base which contains sulfonated methyl ester, sulfonated fatty acid, sodium sulfated, etc., 17.5% stearic acid, 3,85% water, 3% coco fatty acid, 0.1% EDTA, 0.1% fragrance, 0.1% BHT, 0.15% citric acid, 0.2% titanium dioxide, and 0.01% dye. See column 23, lines 10-30. Accordingly, the broad teachings of Ospinal et al anticipate the material limitations of the instant claims.

Allowable Subject Matter

Claim 21 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

With respect to instant claim 21, none of the references of record, alone or in combination, teach or suggest a composition containing a coated alpha fatty acid ester in addition to the other requisite composition as recited by the instant claims.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of copending Application No. 09/574764. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-27 of 09/574764 encompass the material limitations of the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. 6,057,280. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-25 of US 6,057,280 encompass the material limitations of the instant claims.

Response to Arguments

With respect to Rolfes, Applicant states that Applicant's instant claims generally recite a first or detergent portion and a second portion or alpha-sulfofatty acid ester and that the instant claims contain distinct structural elements that distinguish Applicants' claimed invention from that of Rolfes. In response, note that, giving the claims their broadest reasonable interpretation, the Examiner has interpreted a first portion and a second portion which are mixed as recited by claim 1 as simply meaning mixing at least these two components together to form a resultant detergent composition. This interpretation is reinforced by the explanation given on page 4, lines 5-20 of the instant specification, in which it is stated that "each portion typically comprises a plurality of

particles... when the particles are admixed, the particles are co-mingled, but remain physically distinct... the portions can be combined in any suitable ratios, according to the desired properties of the final composition." Clearly, Applicants are taking two different components, mixing them to form a final composition in which the portions are mixed but remain physically distinct as in an agglomeration process, and forming a resultant composition. Thus, the Examiner's interpretation of the instant claims appears to be consistent with the explanation given in the specification. Furthermore, Rolfes teaches bars and granules which are made by mixing distinct components together and the Examiner maintains that this teaching of Rolfes is sufficient to anticipate or render obvious the claimed invention.

With respect to '740 or Kaminsky, Applicants state that these references do not disclose a composition comprising a first or alpha-sulfofatty acid ester portion and a separate, second or detergent portion where the second or detergent portion comprises additional detergent components that cause more than a minor amount of additional di-salt formation. Also, Applicant states that '740 or Kaminsky fail to disclose, teach or suggest that di-salt formation is a problem, that reduced di-salt formation is desired, or any solution to the problem, such as segregating detergent components that cause more than a minor amount of additional di-salt formation from the alpha sulfofatty acid ester.

In response, note that, the arguments made by the Examiner with respect to Rolfes in regard to the structural portions as recited by the instant claims are applicable and pertinent to the compositions taught by '740 or Kaminsky. '740 or Kaminsky teach

granular compositions made by mixing the components together which suggests the claimed invention of mixing the first portion and second portion. With respect to the argument that '740 or Kaminsky fail to address or solve the problem of di-salt formation, the Examiner asserts that the reason or motivation to modify the reference may often suggest what theinventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. In re Linter, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972). See MPEP 2144. Note that, '740 or Kaminsky et al teach granular detergent compositions containing the same components in the same proportions as recited by the instant claims and the Examiner maintains that these references would suggest detergent compositions having the same di-salt formation properties as recited by the instant claims.

With respect to the double patenting rejections set forth in Paper #6, Applicant has not submitted any terminal disclaimers and the rejections have been maintained for the reasons of record.

Conclusion

Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on 1/9/02 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609(B)(2)(i). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory R. Del Cotto whose telephone number is (703) 308-2519. The examiner can normally be reached on Mon. thru Fri. 8:30 thru 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (703) 308-4708. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

GREGORY DELCOTTO
PRIMARY EXAMINER

GRD
April 29, 2002